

Remarks

35 U.S.C. § 103 Rejection of Claims

In the 30 September 2005 Office Action, claims 65 - 100 are rejected as being unpatentable over Bielinski in view of Brown.

The Assignee respectfully traverses the § 103 rejections of claims 65 - 100 in three ways. First, by noting that the Office Action cites a combination of references that teaches away from the proposed combination. Second, by noting that the cited combination of references fails to establish a prima facie case of obviousness. Third, by noting that the cited combination of references fails to make the invention as a whole obvious. The Assignee also notes that there are still other ways in which all §103 obviousness rejections in the 30 September 2005 Office Action for claims 65 - 100 can be traversed.

MPEP § 2145 X.D.2 provides that: "it is improper to combine references where the references teach away from their combination." Bielinski teaches the use of Value Based Management (hereinafter, VBM). VBM teaches and relies on a topology that teaches away from the topology of the neural network models taught by Brown (for example, see Koller, page 8). It clearly would be improper to combine a neural network model that relies on a network topology with a method such as VBM that teaches away from the use of a network topology. In a similar manner, Brown teaches and relies on a network topology that is incompatible with the topology taught by VBM and Bielinski. In short, Bielinski and Brown teach away from their proposed combination.

As discussed previously, the 30 September 2005 Office Action fails to establish the prima facie case of obviousness required to sustain the rejections of claim 65 - 100. MPEP 2142 provides that in order to establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation to modify the reference or combine the reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

As detailed below, the 30 September 2005 Office Action fails to meet all three of the criteria for establishing a prima facie case of obviousness for claims 65 - 100.

The 30 September 2005 Office Action fails to meet the first criteria for establishing a prima facie cause of obviousness for claims 65 - 100 because the two references (Bielinski and Brown) teach away from the theoretical combination contained in the Office Action. It is well established that "teachings of references can be combined only if there is some suggestion or incentive to do so" quoting ACS Hosp. Sys., Inc. v Montefiore Hosp., 732 F.2d 1572, 1577 221 U.S.P.Q 929,933 (Fed. Cir., 1984). In the 30 September 2005 Office Action the Examiner has offered an unsupported opinion that the "well known" use of neural networks for increasing score prediction accuracy provides a motivation for making the proposed theoretical combination. This argument is not persuasive for at least three reasons. The first reason is that the Examiner has not established any relationship between a calculation of accurate scores with any of the method steps of the present invention. The second reason is that this motivation does not appear to be sufficient to overcome the fact that the references teach away from the proposed combination. The third reason is that the Examiner has previously provided a reference, Reilly, "What's is worth?", that made it clear that the state of the art in the relevant fields of practice provided no incentive to complete the claimed analyses. In fact, Reilly makes it clear that there was an incentive not to make the proposed theoretical combination or any other combination to complete the claimed analysis.

The 30 September 2005 Office Action fails to meet the second criteria for establishing a prima facie case of obviousness for claims 65 - 100 because it does not cite a combination of teachings that has a reasonable expectation of success. There are at least two reasons why the cited combination of reference does not have a reasonable expectation of success. The first reason the combination would be expected to fail is that the cited references teach two incompatible topologies. As a result, it would be obvious to those of average skill in the art that the combination could not be used to support the development of a coherent picture of enterprise financial performance. The second reason the combination would be expected to fail is that the completion of the processing for the independent and dependent claims requires the use of a series of data processing and analytical steps that are new, novel and/or non-obvious. The prosecution to date of the instant application and other cross referenced applications has produced substantial evidence that there are dozens of instances of novelty, non obviousness and/or newness relative to the state of the art that are incorporated in the methods, media and/or systems utilized in the claimed invention (note: multiple references for the same instance are counted multiple times). The evidence of novelty, non-obviousness and/or newness relative to the state of the art was established in a

variety of ways including: a documented inability to produce similar results, a documented failure to anticipate claimed methods and/or systems, a teaching away from claimed methods, a documented failure to recognize the problem and/or a teaching away from claimed combinations. Given that there is an overwhelming amount of prior art teaching away from the use of the claimed methods and systems, the creation of tangible, concrete and useful results using the claimed methods and systems would have to be considered a surprising result.

Summarizing the above discussion, the orthogonal teachings of the cited references and a substantial body of evidence developed by the prosecution to date of this application and other cross referenced applications provides convincing proof that the cited combination is an almost certain failure not a probable success.

The 30 September 2005 Office Action fails to meet the third criteria for establishing a prima facie case of obviousness because it does not teach or suggest one or more of the limitations for every claim.

Far from establishing a prima facie case of obviousness for claims 65 - 100, the cited combination of references in the 30 September 2005 Office Action provides additional evidence that the claimed invention for producing concrete, tangible and useful results is new, novel and non-obvious. It does this by calling for a combination of references when the cited references teaches away from their proposed combination, by citing a combination of references when the prior art provided by the Examiner indicates that there is a clear incentive not to make the combination, by advocating a combination of references that is an almost certain failure and by relying on a combination of references that fails to suggest almost all of the claim limitations.

Another way the combination of references cited in the 30 September 2005 Office Action fails to establish a prima facie case of obviousness for claims 65 - 100 is that it fails to make the invention as a whole obvious as required by MPEP § 2141.02 which states that:

In determining the difference between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious but whether the claimed invention as a whole would have been obvious.

As noted previously, the obviousness rejections are based on a combination of Bielinski and Brown. Bielinski teaches away from the method of the instant application in a number of ways. The Brown methodology for value analysis also teaches away from the method of the instant application in a number of ways. As noted previously, the two references also teach away from their own combination. Taken together the cited combination of references fails to make the invention as a whole obvious. The cited combination also fails to make a single aspect of the claimed invention obvious. These failures provide additional evidence that the claimed invention for producing concrete, tangible and useful results is new, novel and non-obvious. Along these same lines, it should be noted that a prior combination proposed by the Examiner for the above referenced application contained references that also taught away from the methods of the claimed invention.

The Assignee notes again that there are still other ways in which all §103 obviousness rejections in the 30 September 2005 Office Action for claims 65 – 100 can be traversed.

The 30 September 2005 Office Action also contains "official notice" regarding the use of technologies that the Examiner claims are well known for use in optimization. The Assignee traverses this claim by noting that the official notice is moot because the Examiner has failed to identify a reference or combination or references that would support the development of a comparable model of enterprise financial performance that could work in conjunction with these "well known" technologies. The Assignee notes that there are still other ways in which the "official notice" contained in the 30 September 2005 Office Action can be traversed.

35 U.S.C. § 112 First Paragraph Rejection of Claims

In the 30 September 2005 Office Action the Examiner has rejected claims 69 - 100 under 35 U.S.C. §112 first paragraph as lacking a written description showing possession of the presently claimed invention. Specifically, the Examiner has alleged that independent claims 69 and 77 include a fourth step of "creating a plurality of network models" that is alleged not to be taught in the specification as filed. The Examiner acknowledges that the specification "discloses use of 'models' and 'casual models.'" Further, and with regard to claim 74, the Examiner alleges that the specification "teaches casual models, not casual network models." The term "models" was used throughout the specification (note, for example, the description of the last paragraph on page 47) and "network" was used to describe the "nodes" (see page 43). The Assignee notes that the description in the specification associated with processing that starts in software blocks 405, 409, 415 and 789 clearly describes the development of neural nets for different aspects of financial performance. Neural nets are network models – a fact that is well known by those of average skill in the art. The use of the network topology is also clearly illustrated by FIG. 10. In other words, the specification and drawings clearly describe the automated development of a plurality of network models. A review of the specification and drawings associated with processing that immediately follows the processing in software blocks 405, 409, 415 and 789 reveals that this part of the processing includes the use of induction algorithms to support the development of causal network models. In summary, the development of a plurality of network models was clearly described in the specification and drawings. As detailed in the specification and drawings, these models are causal network models. The Assignee respectfully requests withdrawal of this rejection.

35 U.S.C. § 112 Second Paragraph Rejection of Claims

In the 30 September 2005 Office Action Claims 70, 81 and 90 were rejected under 35 U.S.C. §112 second paragraph as lacking proper antecedent basis. In claim 70, the Examiner alleges that "the models of aspects of current operation financial performance" lacks antecedent basis in claim 69. Claim 70 was amended to ensure that the claim has proper antecedent basis in claim 69. Therefore the amendment to claim 70 obviates this rejection. With regard to claims 81 and 90, both claims were amended to ensure that the

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claims each have proper antecedent basis in the claims from which claims 81 and 90 depend. Therefore, the amendments to these claims obviate these rejections.

In a second rejection under 35 U.S.C. §112 second paragraph claims 70 and 72 were rejected as indefinite because "it is unclear what method step is performed to further limit" claim 69. Claims 77 and 80 were rejected for the same reason. Claims 82 and 83 were also rejected for indefiniteness. Assignee submits that claims 70, 72, 80, 82 and 83, as amended, are in proper dependent form and do further limit the claims from which each depends.

Claim 70 provides a Markush group to describe the additional method step of "using the network models of aspects of current operation financial performance to complete an analysis" where the analysis is defined through the Markush group. Therefore, claim 70 does indeed provide an additional limitation and is in proper dependent form.

Claim 72 depends from claim 70 and further describes the analyses. Therefore, claim 70 does indeed provide an additional limitation and is in proper dependent form.

Claim 77 is an independent claim so it should not be included in this rejection because it does not further limit a claim.

Claim 80 depends from claim 79 and further describes the "sequence of analytical time series models" described in claim 79. It should be noted that claim 80 was amended to provide correct antecedent basis. Therefore, the amendment to claim 80 obviates this rejection with regard to claim 80.

Claim 82 depends from claim 77 and was amended. Therefore, the amendment to claim 82 obviates this rejection with regard to claim 77.

Claim 83 originally described how "enterprise related transaction data" are obtained. The Examiner rejected claim 83 because the term does not have antecedent basis in claim 77, from which claim 83 depends. Claim 83 was amended herein so that the term now reads "the transaction data for a commercial enterprise" and obtains antecedent basis from the first step of claim 77. Therefore, claim 83, as amended, now has proper antecedent basis. Accordingly, this rejection for claim 83 is obviated.

In summary, the foregoing amendment has obviated the rejections for claims 70, 80, 82 and 83 and the rejection was traversed for claims 72 and 77. Accordingly, the pending claims, as amended, are in proper form for allowance.

Request for affidavits

In the 30 September 2005 Office Action the Examiner has provided an unsupported opinion that the "well known" use of neural networks for calculating accurate scores provides an incentive to make the proposed theoretical combination of Bielinski and Brown. 37 C.F.R. 1.104 provides that:

When a rejection in an application is based on facts within the personal knowledge of an employee of the Office, the data shall be as specific as possible, and the reference must be supported, when called for by the applicant, by the affidavit of such employee, and such affidavit shall be subject to contradiction or explanation by the affidavits of the applicant and other persons.

Accordingly, the Assignee requests that an affidavit detailing the facts in the personal knowledge of any employee(s) of the Office that were used to support the assertions regarding the "well known" uses of neural networks for scoring and the desirability of making the theoretical combination of Bielinski and Brown be provided on or before the date of the next Office Action. For similar reasons, the Assignee requests that an affidavit be provided, in accordance with the requirements of 37 C.F.R. 1.104, that outlines the facts in the personal knowledge of any employee(s) of the Office that were used to support the "official notice" regarding the use of any "well known" optimization technologies on or before the date of the next Office Action.

Support for New Claims

The table below identifies the location in the specification of at least part of the support for the new claims added to the above identified application.

Claim Number	Support in the specification as published includes:
101	Paragraphs 129 - 132
102	Paragraph 110
103	Paragraph 59
104	Paragraphs 62 – 78 and 115-177
105	Paragraph 213
106	Paragraph 27
107	Paragraph 48
108	Paragraph 82
109	Paragraph 124
110	Paragraphs 126 - 128
111	Paragraph 209
112	Paragraphs 62 - 78
113	Paragraphs 129 - 132
114	Paragraphs 179- 185
115	Paragraphs 107 – 114, 179 - 185 and 199
116	Paragraph 197
117	Paragraph 27
118	Paragraph 198

Additional support for the new claims can be found in the drawings, other paragraphs of the specification and one or more cross referenced applications and/or patents.

Information Disclosure Statement

The 30 September 2005 Office Action was accompanied by copies of 8 pages of previously submitted 1448/PTO Forms for the above identified application. The Examiner has initialed 7 of these 8 pages indicating that a review of the disclosed references has been completed. However, the third page, which contains cite numbers 21 through 30 was not initialed. The Assignee respectfully requests that this page be initialed and returned with the next Office Action for the above identified application.

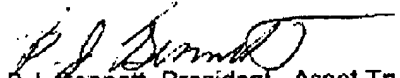
Reservation of rights

The Assignee hereby explicitly reserves the right to present the previously modified and/or canceled claims for re-examination in their original format. The cancellation or modification of pending claims to put the instant application in a final form for allowance and issue should not to be construed as a surrender of subject matters covered by the original claims before their cancellation or modification. The Assignee notes that claims covering most of the subject matter of claims previously cancelled as part of the prosecution of the above identified application are already pending in a continuation application.

Conclusion

The pending claims are of a form and scope for allowance. Prompt notification thereof is respectfully requested.

Respectfully submitted,


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